

REMARKS/ARGUMENTS

Claims 54-69 are currently pending in this application. Claim 64 has been amended and support can be found, for example, on page 23, lines 5-9. Claim 54, 57, and 68 has been amended and support can be found, for example, on page 11, lines 16-18. Claim 59 has been amended and support can be found in the claims and specification as originally filed.

With respect to all claims, Applicants have not dedicated, disclaimed, or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Double patenting rejections

Applicants request that the Examiner hold these rejections in abeyance until notice of allowable subject matter.

Rejections under 35 U.S.C. §112

Claims 54-69 stand rejected under Rejections under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants traverse the rejection. Claim 54 has been amended to recite at least a part of a C_H3 domain of an antibody constant domain” [Emphasis added]. Claim 59 has been amended as suggested by the Examiner. Claim 64 has been amended to recite “a third and a fourth of said polypeptides are each common light chains that are either identical to each other, or are identical to each other within the complementary determining region (CDR) and different to each other outside of the CDR” [Emphasis added]. In addition, Applicants submit that the phrases “heavy chain constant domain” and “heavy chain variable domain” recited in currently pending claim 64 are clear and definite. The term “domain” is currently recited in the claim and therefore a person of ordinary skill in the art would clearly understand its meaning.

Applicants submit that as currently amended, claims 54, 59, 64, and all claims depending therefrom are clear and definite. In light of the foregoing, Applicants respectfully request the withdrawal of this rejection.

Rejections under 35 U.S.C. §102

Claims 64, 65, and 69 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Kostelny (Kostelny, S.A. J. Immunol., 148:1547-1553, 1992; cited in IDS). Claims 64-66 and 69 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Carter (Carter et al. U.S. Patent 5,731,168; issued March 24, 1998; cited in an IDS).

As currently amended, claim 64 recites “common light chains that are either identical to each other, or are identical to each other within the complementary determining region (CDR) and different to each other outside of the CDR” [Emphasis added]. Applicants respectfully submit that neither reference discloses the common light chain as presently claimed. Therefore, Applicants respectfully request that the rejection be withdrawn.

Rejections under 35 U.S.C. §103

Claims 54, 55, 58-61 and 63 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over de Kruif (de Kruif et al., J. Biol. Chem., 271(13):7630-7634, 1996, March; cited in an IDS) as evidenced by Merchant (Merchant et al., Nature Biotech., 16:677-681, 1998, cited in an IDS), in view of Carter (Carter et al. U.S. Patent 5,731,168; issued March 24, 1998; effective filing date March 1, 1995; cited in an IDS).

Claims 54-63 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over de Kruif (de Kruif et al., J. Biol. Chem., 271(13):7630-7634, 1996, March; cited in an IDS) as evidenced by Merchant (supra) in view of Carter (supra) and further in view of Greenwood (Greenwood, J. et al., Ther. Immunol., 1(5): 247-255, 1994).

Claims 64-69 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Carter (Carter et al. U.S. Patent 5,731,168; issued March 24, 1998; effective filing date March 1, 1995; cited in an IDS) in view of Greenwood (supra).

However, under 35 U.S.C. §103(c)(1), Carter et al. U.S. Patent 5,731,168 may not be properly cited by the Examiner as grounds for an obviousness rejection. 35 U.S.C. §103(c)(1) states:

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Carter et al. cannot preclude patentability of the present invention under 35 U.S.C. §103 because it would only qualify as prior art under 35 U.S.C. §102(e), (f), or (g) and at the time the present invention was made Carter et al. was owned by the Applicants. The publication date of Carter et al. is the issue date of March 24, 1998. As such, Carter et al. is not prior art under 35 U.S.C. §102(a) or (b) because it published after the priority date of the instant application. Also, Carter et al. is not a prior art reference under 35 U.S.C. §102(c) or (d). Therefore, Carter et al. could only be considered as alleged prior art under 35 U.S.C. §102(e), (f), or (g).

In accordance with the requirements to establish common ownership in M.P.E.P. §706.02(l)(2), the instant U.S. Patent Application No. 09/520,130 and Carter et al. were, at the time the invention of the instant application was made owned by Genentech, Inc. Therefore, according to 35 U.S.C. §103(c)(1), Carter et al. cannot preclude patentability of the presently claimed invention under 35 U.S.C. §103. Because Carter et al. does not qualify as prior art, Applicants request that the rejections be withdrawn.

Response to Office Action
(Dated: October 5, 2007 – Paper No. 20070926)
Application Serial No. 09/520,130
Attorney's Docket No. 39766-0215 R2C1

CONCLUSION

In light of the above amendments, Applicants believe that this application is now in condition for immediate allowance and respectfully request that the case be passed to issue.

Please charge any fees that might become applicable, including any fees for extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39780-0215R2C1.

Respectfully submitted,
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Dated: December 26, 2007

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